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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/934,973	08/22/2001	Timothy P. Croughan	98A9-USC1 Croughan	8353
25547	7590	06/23/2006	EXAMINER	
PATENT DEPARTMENT TAYLOR, PORTER, BROOKS & PHILLIPS, L.L.P P.O. BOX 2471 BATON ROUGE, LA 70821-2471			KRUSE, DAVID H	
			ART UNIT	PAPER NUMBER
			1638	

DATE MAILED: 06/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/934,973

Applicant(s)

CROUGHAN, TIMOTHY P.

Examiner

David H. Kruse

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 62, 63, 69, 71, 72, 82 and 85-95 is/are pending in the application.
- 4a) Of the above claim(s) 63, 69, 71, 72, 82 and 85-95 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR § 1.114

1. A request for continued examination under 37 CFR § 1.114, including the fee set forth in 37 CFR § 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR § 1.114, and the fee set forth in 37 CFR § 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR § 1.114. Applicant's submission filed on 11 April 2006 has been entered.

Election/Restrictions

2. Claims 63, 69, 71, 72, 82 remain withdrawn and new claims 85-95 are withdrawn as directed to an invention non-elected without traverse in the response filed 14 January 2003. Applicant's statement concerning rejoinder on page 5 of the Remarks is noted.
3. Claim 62 is under examination.

Status of the Application

4. The Examiner has withdrawn the rejection under 35 U.S.C. § 112, first paragraph for enablement in view of statement on page 8 of the Remarks.
5. The rejection under 35 U.S.C. § 101, for double patenting is withdrawn in view of Applicant's amendment.
6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

7. Claim 62 remains rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This rejection is repeated for the reason of record as set forth in the last Office action mailed 6 October 2005. Applicant's arguments filed 11 April 2006 have been fully considered but they are not persuasive.

Applicant argues that a "fingerprint" description is an accepted manner to claim a composition that may have only been partially characterized as of the filing date (page 6 of the Remarks). Applicant argues that claim 62 does not attempt to claim any and all herbicide-resistant rice plants, rather defines a "fingerprint" of herbicide-response characteristics (page 7 of the Remarks). Applicant argues that the "fingerprint" definition satisfies the goal of giving innocent third parties notice of what the claimed invention is (page 7 to page 8 of the Remarks). These arguments are not found to be persuasive. As the invention of claim 62 appears to be directed to a progeny produced from an undefined number of crosses or back-crosses, Applicant has failed to adequately describe the invention as broadly claimed. Applicant does not describe what structural feature of the rice plant having ATCC accession number PTA-904 has that confers the function feature of the claimed invention. The "fingerprint" description, as argued by Applicant, does not describe what the specific structural feature, the claimed herbicide-resistant rice plant has. There could be multiple mutations in a rice

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AHAS gene that would lead to the "fingerprint" herbicide resistance as asserted by Applicant. At the time of the invention, the description in the instant specification fails to put the public on notice as to what would be infringing as stated in the previous Office action. See, MPEP § 2163 which states that the claimed invention as a whole may not be adequately described where an invention is described solely in terms of a method of its making coupled with its function and there is no described or art-recognized correlation or relationship between the structure of the invention and its function. A biomolecule sequence described only by a functional characteristic, without any known or disclosed correlation between that function and the structure of the sequence, normally is not a sufficient identifying characteristic for written description purposes, even when accompanied by a method of obtaining the claimed sequence.

Claim Rejections - 35 USC § 102/103

8. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 62 is rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Terakawa *et al* 1992 (Japan. J. Breed. 42:267-275) taken with the evidence of Bernasconi *et al* 1995 (J. Biological Chemistry 270(29): 17381-17385) and Hattori *et al* 1992 (Molecular and General Genetics 232: 167-173). This rejection is modified from the rejection of record as set

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forth in the last Office action mailed 6 October 2005. Applicant's arguments filed 11 April 2006 have been fully considered but they are not persuasive.

Applicant argues that the basis for distinction is that Terakawa discloses the use of bensulfuron methyl, which is a sulfonylurea herbicide, and that independent Claim 62 has been amended to refer to selection with a "herbicidally-effective imidazolinone" (parts (b) and (c)). Applicant argues that independent Claim 62 also requires resistance to five specific imidazolinone herbicides (part (e)), and that Terakawa discloses no plants that purport to be resistant to imidazolinones (page 9 of the Remarks).

These arguments are not found to be persuasive.

Bernasconi *et al* provide evidence that a single point mutation can confer broad range tolerance to herbicides that target acetolactate synthase (see page 17381).

Hattori *et al* provide evidence that separate mutations can produce multiple resistance to sulfonylureas and imidazolinones (see entire document).

Applicant has provided no evidence that the herbicide-resistant rice plants disclosed by Terakawa *et al* do not inherently have the herbicide resistance "fingerprint" of the instant claimed rice plant. While Terakawa *et al* are silent as to the imidazolinone resistance and the type of sulfonylurea resistance of the disclosed herbicide resistant rice plants, it is clear that imidazolinone resistance is inherent in mutant plants as evidenced by the prior art. The Office does not have the facilities and resources to provide the factual evidence needed in order to establish that the product of the prior art does not possess the same, material, structural and functional characteristics of the claimed product. In the absence of evidence to the contrary, the burden is on the Applicant to provide that

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the claimed product is different from those taught by the prior art and to establish patentable differences. See *In re Best* 562F.2d 1252 USPQ 430 (CCPA 1977) and *Ex parte Gray* 10 USPQ 2d 1922 (PTO Bd. Pat. App. & Int. 1989).

In the alternative, the claim would have been obvious to one of ordinary skill in the art at the time of Applicant's invention because, it would have been clear to one of ordinary skill in the art that mutant rice plants with multiple herbicide resistance to imidazolinones and sulfonylurea herbicides could be selected using the teachings of Terakawa *et al.* Given the knowledge of those of ordinary skill in the art at the time of Applicant's invention, those of skill in the art would have had a reasonable expectation of success.

Double Patenting

10. Claim 62 remains rejected under the judicially created doctrine of double patenting over claim 11 of U. S. Patent No. 6,943,280 B2. This rejection is repeated for the reason of record as set forth in the last Office action mailed 6 October 2005. Applicant's arguments filed 11 April 2006 are noted but a rejection cannot be held in abeyance (see page 10 of the Remarks).

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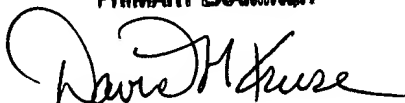
Conclusion

11. No claims are allowed.
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David H. Kruse, Ph.D. whose telephone number is (571) 272-0799. The examiner can normally be reached on Monday to Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached at (571) 272-0975. The central FAX number for official correspondence is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (571) 272-1600.

**DAVID H. KRUSE, PH.D.
PRIMARY EXAMINER**



David H. Kruse, Ph.D.
20 June 2006

1. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

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